

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. No claims are amended.

Rejection of Claims 13 and 17 Under 35 U.S.C. §101

The Office Action rejects claims 13 and 17 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Applicants traverse this rejection and urge the Examiner accept this embodiment of the invention. The “forms of energy” that are discussed in Guidelines Section Annex IV, part c include such basic forms as “frequency, voltage or strength of a magnetic field.” Applicant’s claims are to a bitstream generated by a method of coding data. As such, they are standard “product by process” claims. The product is the bitstream and not a “form of energy such as a frequency, voltage or strength of a magnetic field” but a stream of bits organized according to the method of coding data set forth in the claims. Furthermore, while claims to frequency, voltage or strength of a magnetic field are not issued, there are many patents issuing now with claims directed to bitstreams. See, e.g., US Pat. No. 7,117,373 (issued Oct. 3, 2006),

Rejection of Claims 1, 5-7, 18-19, 22-26, 30 and 34 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 5-7, 18-19, 22-26, 30 and 34 under 35 U.S.C. §103(a) as being unpatentable over Chu et al. (U.S. Patent No. 5,367,629) (“Chu et al.”) in view of Morihara et al. (U.S. Patent No. 6,542,640) (“Morihara et al.”). Applicant respectively traverses this rejection and submits that there is still insufficient analysis to establish a prima facie case of obviousness.

Applicant in a previous response pointed out the substance of why one of skill in the art would not have sufficient motivation to combine Chu et al. with Morihara et al. As stated in several responses to office actions, Applicant submits that because Chu et al. teach video

compression and transmission over a 14.4 kbps bandwidth and because Morihara et al. relates to a dictionary which has a character train (specifically one from an Asian language) as a processing unit. When one of skill in the art looks at the title, picture on the cover of the patent and abstract of Chu et al., he or she would clearly recognize the context of the reference: video compression using a vector adaptive transform. In contrast, when that person would be presented with Morihara et al. and their title, abstract, front page picture as well as the first paragraph of column 1 cited by the Office Action, it becomes instantly clear that the reference relates to compressing and reconstructing “document data formed by character codes of a language such as Japanese, Chinese, Hangul, or the like having a word structure which is not separated by spaces.” Col. 1, lines 12 – 15. Therefore, given that Morihara et al. not only do not deal with video compression but clearly teach a particular approach for documents that have particular features of uniquely Asian languages, would the person of skill in the art be *motivated* to look further into Morihara et al. for information or techniques that might help in video compression? Applicant respectfully submits that there is insufficient motivation given the context and teachings of the references when objectively analyzed.

Applicant notes that MPEP 2143.01 states that “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitute, combination or other modification.” In this case, Applicant urges that the answer is clearly that one of skill would not read Morihara et al. and be motivated to combine its teachings with Chu et al. The more one reads of Morihara et al., the deeper into character trains and dictionary type coding one gets. Accordingly, even delving further into this reference does not help to alleviate the impressions given by reviewing the basic information that Morihara et al.’s teachings differ dramatically from Chu et al.

Applicant further notes that after several discussions regarding the Examiner's burden to establish a prima facie case of obviousness, that the outstanding office action nevertheless fails to make a prima facie case. For example, on page 4 of the current Office Action, the reason for combining the references is that these two references are "from the same field of invention." However, the MPEP expressly states that simply because references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEPG 2143.01, Section III. That secondary analysis is missing in this case.

MPEP 2144.08 Section III requires that the Office once it receives rebuttal evidence of the type Applicant has provided herein and in previous responses, that it must "reconsider any initial obviousness determination in view of the entire record." The Office Action that maintains the rejection should "communicate the Office's finding and conclusion, articulating how the conclusions are supported by the findings." Applicant respectfully notes that the current status of the Section 103 rejections after filing an RCE is that Chu et al. and Morihara et al. are in the same field of endeavor (not evidence to combine or a reason to combine) and a discussion on page 4 of the teachings of Morihara et al. without any reference to the teachings of Chu et al. and how they suggest combination. For example, the Office Action states that they are in the same field of endeavor and are combinable because Morihara et al. relates to data compression etc and apply to characters codes of a language such as Japanese. There is no discussion of Chu et al. and why these references *suggest* combination. Applicant has provided several reasons based on the substantive suggestion power of each reference as to why they should not be combined.

Furthermore, the Office Action states that Morihara et al.'s teachings at col. 2, lines 9 – 20 should be incorporated into Chu et al. Applicant traverses this analysis because Morihara et al. in this portion teach that there are three kinds of "LZ78 systems and probability static type codings irrespective of an actual appearance frequency of a non-

compression data train.” Col. 2, lines 9 – 11. These LZ78 systems are dictionary type codings for documents. See Col. 1, lines 41 – 43 which discusses document data compression. One of skill in the art would easily recognize that the LZ78 systems which the Office Action asserts would be obvious to take from Morihara et al. and insert into Chu et al. do not relate to video compression but are used for document data compression. If the Patent Office is successful at combining these two references because they are “in the same field of endeavor” then the substance of the standard obviousness analysis is weakened to the point of being inapplicable in this case. Applicant respectfully requests that the objective suggestive power of each reference be analyzed and applied such that the details above are considered appropriately.

Applicant also notes that the reference to semi-adaptive and non-adaptive coders in the “related art” section is move in the amendment above in the specification. No new matter is added. Applicant asserts that the MPEP requires admitted prior art only apply where applicant has made a statement that the work of another is “prior art”. MPEP 2129. That statement has not been made in the specification and has not been made during prosecution. There is a clear different between “relevant art” and “prior art”. Relevant art may be art that was published after the filing date of an application and thus not “prior” art. Accordingly, to make clear that Applicant is not admitting that semi-adaptive and non-adaptive coders are prior art, the specification changes are made above. Applicant requests withdrawal of the conclusion that Applicant has admitted prior art.

Accordingly, Applicant respectfully submits that once an objective and complete Section 103 analysis is done on the two cited references that one of skill in the art would not have motivation to combine Chu et al. with Morihara et al. Therefore, claims 1, 5 – 7, 18 – 19, 22 – 26, 30 and 34 are patentable and in condition for allowance.

CONCLUSION

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the Isaacson, Irving, Stelacone & Prass, LLC, Account No. 50-2960 for any deficiency or overpayment.

Respectfully submitted,

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